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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,967	12/09/2003	John Harvie Chaffin III	46872-292128	3674
7590	04/05/2006		EXAMINER	
Everman Law Firm, PA 6000 Fairview Road Suite 1200 Charlotte, NC 28210			TURNER, ARCHENE A	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/730,967	CHAFFIN, JOHN HARVIE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Archene Turner	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 January 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 32-40 is/are pending in the application.  
 4a) Of the above claim(s) 40 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7,32-39 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1775

1. Newly submitted claim 40 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: this claim belongs with group II drawn to a coated substrate, which was not elected

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 40 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7,32-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu et al (5,209,812) or Aida (5,225,275).

Wu et al or Aida disclose the claimed diamond film having very low graphite inclusion (see fig. 8 for '812 and fig. 5 for '275) within the claimed thickness. The claimed stress and roughness is considered inherent.

4. Claims 1-7,32-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Philips Patntverwaltung Gmbh (DE 3047888)

Philips Patntverwaltung GmbH discloses a diamond film with the claimed thickness that has a lattice structure similar to diamond, which suggests the exclusion of graphite in the film.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4,6,32-33,36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruen et al (as before).

The rejection is maintained for reasons of record in the previous office action. Applicant's arguments filed 1/12/2006 have been fully considered but they are not persuasive. The applicant argues that because the reference includes hydrogen in the method that graphite is included in the final film. This is not found persuasive since other references that include hydrogen as a precursor show that the graphite in the diamond film is etched away from the final product, and thus the rejection stands. The applicant is reminded that the elected claims are product claims and when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product in a product by process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the product differs in

Art Unit: 1775

kind from those of the prior art (*In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)).

This burden is NOT discharged solely because the product was derived from a process known to the prior art (*In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday, Wednesday through Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ARCHENE TURNER  
PRIMARY EXAMINER